

Application No.: 09/437378

Docket No.: OIQ-001RCE

REMARKS**Numbered Paragraph 1**

Applicants respectfully suggest that the amendments discussed by the Examiner and Applicants representative constitute a novel invention. Applicants request a telephone interview to discuss this matter further in the event the issues raised in paragraph 2 are resolved to the Examiner's satisfaction. Applicants also wish to point out that the paper discussing the telephone interview (interview summary?) to which the Examiner refers in paragraph 1 did not come attached to the copy of the Miscellaneous Letter that Applicants received and Applicants therefore are unable to respond to any specific points raised in the (interview summary?).

Numbered Paragraph 2**Possible 35 U.S.C. §102(f) Issues Raised in Protest**

In brief, the protest filed on October 10, 2003 (hereafter "the protest") alleged that Herbert Van de Sompel was a non-named inventor for Applicants invention and that therefore Applicants are not entitled to a patent for their invention. In response, Applicants submit, pursuant to 37 C.F.R. §1.132 a signed declaration by Inventor Eric S. Hellman (see attached). Applicants respectfully suggest that the Declaration refutes the points raised by the Declaration of Herbert Van de Sompel and declares that Herbert Van de Sompel was not an inventor of Applicants claimed invention.

35 U.S.C. §102(b) Issues Raised in Protest

35 U.S.C. §102(b) provides that a person shall not be entitled to a patent if "the invention was patented or described in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States." The filing date accorded to Applicants is November 10, 1999. None of the references submitted in the protest pre-date the filing date by more than one year. Accordingly, none of the references are sufficient to maintain a 102(b) rejection. Applicants additionally note that the references fail to disclose all of Applicants claim limitations of Applicants claims as set forth in more detail below.

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Possible 35 U.S.C. §102(a) Issues Raised in Protest

Applicants note at the outset that the Examiner has not made specific rejections pursuant to 35 U.S.C. §102(a) based upon any of the references submitted in the protest and accordingly will treat this Miscellaneous Letter as a generalized request for comment by the Applicants on the assertions contained in the protest. Applicants respectfully suggest that none of the references submitted in the protest provide sufficient support for a 35 U.S.C. §102(a) rejection.

Applicants take issue with the central argument of the protest which starts by transforming the claimed invention by redefining the terms used in the specification in order to show the existence of anticipatory references. More specifically, the protest attempts to redefine the terms consistent with Mr. Van de Sompel's work rather than in a manner consistent with the claimed invention. Some of this confusion may stem from the fact that the protest seems to be based upon a published PCT application reflecting an early version of the claims rather than the current state of the claims as they exist four plus years into the prosecution of the United States Application. More specifically, the Applicants and the Examiner have discussed extensively the meaning of the claim terms "controlled vocabulary abstract hyperlink" and "redirection facility" and have revised the claims consistent with those discussion. The claimed terms are not the same as the terms are defined in the protest argument.

The protest makes a generalized assertion that most of the references provide "all" of the limitations of the claims (this begs the question as to which of the references do not contain all of the limitations). As noted, the current version of the claims has been extensively amended and Applicants respectfully suggest that none of the references contain the controlled vocabulary abstract hyperlink" and "redirection facility" limitations as claimed by Applicants. In support of the protest, the protestors submitted an October 1999 article by Mr. Van de Sompel from D-Lib magazine which breaks down three categories of selective resolution based on the nature of the service component and the redirection order. The article states:

- Category 1 only has a central service component and hence a central redirection mechanism. To some extent, this is the category under which the NCBI LinkOut solution resides. Still, since that solution is tied in with the PubMed database and cannot be used in connection with other resources, it can hardly be seen as a real

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service component in the sense described earlier.

- Category 2 has both a central and a local service component that contribute to the presentation of the services. Also, there is some form of communication between both. For this Category, it is possible to imagine both approaches regarding the redirection order mentioned above.

- Category 3 builds purely on a local service component and hence also needs a local redirection mechanism. The SFX implementations of both the Elektron and "SFX@Ghent & SFX@LANL" experiments fall within this Category.

[see page 7 of "Reference Linking in a Hybrid Library Environment"]

Mr. Van de Sompel's work falls in the category 3 area and the article discusses that group of systems. The claimed invention would fall within the second category. Furthermore, the statement that "there is some form of communication between [the local and central service components]" is not true in the claimed invention, indicating it is clear that Mr. van de Sompel did not understand the details of how a "Category 2" could be implemented. As noted during many discussions with the Examiner and in the previous revisions to the claims, the Applicants redirection facility does not communicate with the resolution services as claimed in this article. This aspect of the Applicants redirection facility is a central feature to the claimed invention as it allows for signal scalability and thus can accommodate many thousands of targets. Applicants also note that this paper was written after Applicants confidentially disclosed their invention to Mr. van de Sompel in the summer of 1999. Applicants respectfully suggest that the protest assertions and Mr. Van de Sompel's articles show his imperfect grasp of Applicants' invention which stems from the fact that the Applicants invention was different from Mr. Van de Sompel's work. The definition of "redirection facility" used by Mr. Van de Sompel in his paper and the protest is so broad that it includes an html menu of links and would encompass virtually every web page on the Internet. By contrast, the claimed redirection facility accomplishes specific routing through http redirection.

The protest presents a circular argument which first redefines more broadly the claimed invention's terms and then argues that the broader terms are consistent with Mr. Van de Sompel's work. All of the references (including the Caplan et al references) are offered in the

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protest in support of these broader redefinitions and Mr. Van de Sompel's work and use a different mechanism for resolving links. It is respectfully suggested that the Examiner has already worked with Applicants to clarify their claims during prosecution sufficiently to distinguish the claimed invention from all of these references. Should the Examiner wish to assert any of these references, Applicants will be happy to respond to a properly formatted limitation by limitation rejection proposed by the Examiner indicating where the limitation is revealed in the reference rather than the generalized suggestion of anticipation offered in the protest.

Applicants also remind the Examiner that under 37 C.F.R. §1.291(c) the protestor is limited to the initial submission of documents. Applicants will be happy to respond to any further inquiries from the Examiner but are not required to engage in a back and forth discussion with a third party making generalized allegations which do not represent a properly formatted basis for a rejection.

Accordingly, Applicants request the protest be dismissed.

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CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due in connection with this response. In the event a fee is due, please charge our Deposit Account No. 12-0080, under Order No. OIQ-001RCE from which the undersigned is authorized to draw.

Dated: June 21, 2004

Respectfully submitted,

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